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PATENT
Serial No. 09/829,151

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Alan Young
Serial No. 09/829,151
Filed: April 9, 2001
Group Art Unit: 3629
Examiner: Tan D. Nguyen
Title: *System and Method for Integrated Data Analysis and Management*

Mail Stop AF
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

The following Pre-Appeal Brief Request for Review ("Request") is being filed in accordance with the provisions set forth in the Official Gazette Notice of July 12, 2005 ("OG Notice"). Pursuant to the OG Notice, this Request is being filed concurrently with a Notice of Appeal. Applicant respectfully requests reconsideration of the rejected claims in the Application.

In the prosecution of the present Application, the PTO's rejections and assertions contain clear errors of law and/or fact. As a result, the rejections and objections of the Final Office Action sent electronically July 29, 2008 (the "Final Office Action") and the Advisory Action sent electronically October 22, 2008 (the "Advisory Action") are improper as detailed below.

Claims 12 and 13

The Final Office Action objects to Claims 12 and 13 for allegedly failing to further limit the claim from which they depend and also rejects Claims 12 and 13 for unknown reasons.¹ *See* Final Office Action, pp. 2, 3, and 9 (presenting rejections of only Claims 1-7 and 9-10). In Applicant's Response to Final Office Action filed electronically September 29, 2008 (the "Response to Final OA"), Applicant noted that the elements in Claims 12 and 13 recite additional steps that are not present in Claim 1. *See* Response to Final OA, pp. 5-7. Specifically, Claim 12 recites:

The method of Claim 1, further comprising:
determining whether to request additional information about the business event based at least in part on the business data included in the business event message;
requesting the additional information from an information provider;
and
wherein electronically determining the value of the key performance indicator comprises electronically determining the value based at least in part on the business data and the additional information.

Claim 13 recites:

The method of Claim 1, wherein the business event message further includes a successor event and an expected time period for the successor event to occur, and further comprising:
displaying a message for the successor event when the expected time period has been reached and the successor event has not occurred.

Thus, the elements of Claims 12 and 13 clearly provide further limitations to Claim 1.

The Examiner dismisses this argument by simply asserting that Claims 12 and 13 "are also being considered as NFDM [nonfunctional descriptive material] and have no patentable weight as described above." Advisory Action, p. 2. The Examiner provides no statutory or case law basis for treating the relevant claims as "nonfunctional descriptive material" however. The Examiner merely points to M.P.E.P. § 2106.01 for the definition of descriptive material, but provides no explanation as to why the identified claim elements satisfy this definition. Advisory Action, p. 2. Applicant respectfully disputes the Examiner's assertion that the "determining . . ." and "requesting . . ." elements of Claim 12 and the "displaying . . ." element of Claim 13 comprise NFDM. The identified claim

¹ The Final Office Action fails to explain the basis for rejecting Claims 12 and 13, and only presents an objection to these claims. Applicant assumes that Claims 12 and 13 were rejected under 35 U.S.C. § 103 on the same grounds as Claim 1 without consideration of the additional elements recited by these claims.

elements represent functional elements of the claimed methods. There is no basis for treating these functional elements as “*non-functional* descriptive matter.”

Furthermore, even if the Examiner were correct regarding whether the identified claim elements represent NFDM, the portion of M.P.E.P. § 2106.01 cited by the Examiner addresses whether NFDM is statutory subject matter under 35 U.S.C. § 101; however, the Examiner appears to reject Claims 12 and 13 under 35 U.S.C. § 103. The Examiner seems to concede that Claims 12 and 13 recite a method that is statutory subject matter under § 101. Instead, the Examiner uses the definition of NFDM and the standard for determining patentability of NFDM under 35 U.S.C. § 101 to argue that the relevant elements are not entitled to patentable weight. See Advisory Action, p. 2. The M.P.E.P., however, explicitly addresses the relevance of NFDM to § 103 rejections later in this same section. Specifically, with regards to NFDM, M.P.E.P. § 2106.01 states:

USPTO personnel should inquire whether there should be a rejection under 35 U.S.C. 102 or 103. USPTO personnel should determine whether the claimed nonfunctional descriptive material be given patentable weight. *USPTO personnel must consider all claim limitations when determining patentability of an invention over the prior art.* USPTO personnel may not disregard claim limitations comprised of printed matter.

M.P.E.P. § 2106.01, emphasis added, internal citation omitted.

Thus, even if the identified elements were properly deemed NFDM that fact, without more, would not deprive them of patentable weight. “All words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03 (citing *In re Wilson*, 424 F.2d 1382, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970)).

Numerous cases support this proposition, including several cited by the Advisory Action as the basis for this rejection. For example, in *In re Lowry*, the Federal Circuit, in overturning a § 103 rejection premised on the Examiner’s determination that the claimed (“ADOs”) were NFDM, emphasized that “[a]s part of its burden to establish a *prima facie* case of obviousness, the burden of establishing the absence of a novel, nonobvious functional relationship rests with the PTO.” *In re Lowry*, 32 F.3d 1579, 1584 (Fed. Cir. 1994) (internal citation omitted). “If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent.” *Id.* Similarly, in *In re Gulack*, the Federal Circuit stated:

What is required is the existence of *differences* between the appealed claims and the prior art sufficient to establish patentability. *The bare presence or absence of a specific functional relationship, without further analysis, is not dispositive of obviousness.* Rather, the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate.

In re Gulack, 703 F.2d 1381, 1386 (Fed. Cir. 1983) (emphasis added).

Thus, regardless of the alleged presence of NFDM, the question is whether the claims describe a new and unobvious functional relationship, which the identified elements clearly do. As one example, Applicant's Claim 12 recites "determining whether to request additional information about the business event based at least in part on the business data included in the business event message." Thus, the identified element provides a new and unobvious functional relationship between the claimed "additional information" and "business data." As another example, Claim 13 recites "displaying a message for the successor event when the expected time period has been reached and the successor event has not occurred." Thus, the identified element provides a new and unobvious functional relationship between the claimed "message for the successor event" and the "expected time period." Consequently, the identified elements should be given patentable weight.

Thus, the objection to and/or rejection of Claims 12 and 13 includes clear factual and/or legal errors. Applicant respectfully requests reconsideration and allowance of Claims 12 and 13.

Claims 1-7 and 9-10

Claims 1-7 and 9-10 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over a combination of non-patent references, including *Oracle*, *PeopleSoft*, and *Cognos*. As Applicant previously noted, the proposed combination fails to disclose several elements of the rejected claims. *See, e.g.*, Response to Final OA, pp. 7-9.

The Examiner dismissed these deficiencies by again improperly determining that the elements identified by Applicant comprised only NFDM. Final Office Action, p. 9. As previously noted, Applicant respectfully traverses this characterization. Furthermore, as explained above, the mere fact that claim elements relate to NFDM does not, without more, deprive those elements of patentable weight.

Additionally, with respect to the Examiner's arguments that certain elements are inherent, Applicant respectfully notes that "[t]o establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference." M.P.E.P. § 2112 (emphasis added). "The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Id.* (emphasis added). The Examiner asserts, without any evidentiary support, that "[a]s for the functions of the information and message received in the 1st and 3rd steps, these are **normally included** in the monitoring or querring [sic] of data for relevant information related to the KPI." Advisory Action, p. 2 (emphasis added). Even if these are "normally included," as claimed by the Examiner, this statement fails to meet the standard that the matter be "necessarily present" as set forth above.

Thus, the proposed combination fails to disclose every element of Claims 1-7 and 9-10, as Applicant previously explained. *See, e.g.*, Response to Final OA, pp. 7-9. As a result, the rejection of Claims 1-7 and 9-10 contain factual and/or legal errors.

CONCLUSION

As a *prima facie* rejection has not been established against Applicant's currently rejected claims, Applicant respectfully requests a finding of allowance of all claims in the Application.

To the extent necessary, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,
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